UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,484	10/10/2001	Chee Beng Lim	LIMCP002	9782

25920	7590	03/07/2005	

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EXAMINER
JANVIER, JEAN D

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	**Applicant(s)**
		09/975,484	LIM, CHEE BENG
Office Action Summary		**Examiner**	**Art Unit**	
		Jean D Janvier	3622	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-8* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____ .
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .
4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____ .

DETAILED ACTION

Specification

The title of the invention is not descriptive so as to help one having ordinary skill in the art understand the nature of the subject matter. A new title is required that is clearly indicative of the invention to which the claims are directed. Further, it appears that the title of the invention is too long, that is more than 500 characters. See 37 CFR 1.72.

Throughout the specification, "loyalty numbers" should apparently be --loyalty points--.

Information Disclosure Statement

The listing of references (US Patents 5,025,372 and 6, 018, 718) in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Status of the claims

Claims 1-8 are pending in the Instant Application.

Claim Objections

Claim 1 (including its dependent claims) is objected to because of the following

informalities:

Throughout the claimed invention, "loyalty numbers" should apparently be --loyalty

points--.

Concerning claim 1, lines 19-20, "updating all records therein the computer server..."

should apparently be --updating all records **in** the computer server...--.

Concerning claims 3 and 4, the limitations recited therein are interpreted as --...one or

more recipients' names or identifiers are randomly selected **manually** or **by the computer** as

potential reward recipients for each program in accordance with predetermined rules for each of

the program--.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Eggleston,

US Patent 6,061,660A.in view of Ikeda, US Patent 5,937,391A.

As per claims 1-8, Eggleston discloses a system wherein a consumer visits on the Internet

a host system web site, having one or more servers, and registers with the host system in order to

participate in an incentive program, comprising a plurality of incentives including games of

chance and/or skill, offered by a plurality of sponsors. To this end, a consumer operating on a

consumer computer 12 uses a local web browser 50 to locate the consumer site 192 of the host

computer 18 (host system). Once the consumer has located the consumer site 192 (a web site

having a plurality of web pages) and enters the URL related to the site 192 into the local browser

address field, the consumer is given various options **displayed thereon in menu format, text**

and/or graphical image format. The consumer may register to become a member of the host

incentive program system by entering various pieces of information in a predetermined format. If

the consumer registers at the consumer site 192 (web site) of host system, then the consumer is

issued an identification number and an associated password **(displaying an indication or**

marker related to the incentive program system and enabling the user to register before he

can participate in the incentive program system). Alternatively, registration may also be

completed through stand-alone computer software, in which case the consumer is issued a disk

on which a program is stored that, when installed, prompts the consumer to complete the

information necessary for registration. In the case of the software version of registration, the

consumer downloads the software to a disk and can send it to the host system by electronic mail

(off-line registration or registration via e-mail-fig. 2; col. 12: 22-48).

When the consumer registers, a record is created in the consumer database 200, storing

the users' registration data collected from the users during a registration process conducting

online at web site 192 and off-line, reflecting the registration of the consumer and including the

personal associated identification number, password, or the like. Referring to FIG. 17, the

consumer database 202 includes records that may include the name 800, address 802, **e-mail**

address 804, phone number 806, identification number 808, password 810, and account number

812. Other database records of the consumer database 200 may include sub-records 814

recording various data. A set of participation sub-records 816 may record historical participation

in each of the incentive programs by the consumer. A winning sub-record 818 may record

information regarding winning activities by the consumer. An award or points sub-record 820

may record loyalty points or prizes won by the consumer. A psychographic or demographic

(profile) sub-record 822 may include information obtained through consumer responses to

inquiries answered by the consumer during participation in incentive programs. Any number of

other sub-record containing information about the consumer or about the consumer's

participation in incentive programs should be understood to be encompassed within the present

system (fig. 17;col. 13: 7-28).

Furthermore, once the consumer database 200 is established, it is easy to detect non-

registered users upon logging into the web site 192 by searching the consumer database 200

through any common search application, which may be included within the database program

used to build the consumer database 200. For example, the consumer database 200 may be an

Oracle database with an Oracle application, which permits searching of the Oracle databases. If

at the step 309 the name is found in the consumer database 200, then the HTTP server is

instructed by the application program to display an HTML page that prompts the user to input

the user's password at the step 311. If the user's name is not found on the consumer database 200

at the step 309, then the HTTP server causes the system to display an HTML page that queries

whether the consumer wishes to register as a member of the host system in a step 306. The

HTML page includes a "yes" button and a "no" button, or similar ability to respond in the

affirmative or negative to the query. Such buttons may be graphical objects coded by an

application suitable for running in a web page, such as a Java applet. When the user responds

with a "no", the HTTP server displays an HTML message that indicates that registration is

required in order to participate in the site, and the user is logged out of the site at a step 320 (fig.

8).

Additionally, upon registering, the consumer's registration data are stored in database

200 for later retrieval and global use. It should further be noted here that the incentive programs

that are built or purchased through the sponsor system are coded to permit a consumer to **enter**

an incentive program at a different site without requiring additional registration or

additional entering of a name or password. That is, the registration routine of the incentive

program running on a sponsor's site automatically initiates, by a CGI script or similar

application, a query to the consumer database 200 to confirm that the user is a registered

consumer. Upon receiving confirmation that the user is a consumer of the host system, the

application program automatically registers the consumer for the incentive program, avoiding

unnecessary multiple registrations for different incentive programs by the same consumer.

Alternatively, the consumer may initially register at a particular sponsor's site, in which case

registration is effective for all sites, because the registration routine automatically updates the

consumer database 200 (col. 25: 15-49).

Moreover, besides the registration process (providing an indication to the user to supply

registration information), Eggleston continues, the consumer site or the web site 192 includes

hypertext links (markers) or other connections to various other sites (host site servers),

applications and information. Thus, the customer or consumer can link to information pages that

describe the host incentive program system, particular incentive programs or provide other

information related to the system. Here, the consumer may link to incentive programs that are

provided in a directory of incentive programs, provided by the operator of the host system or a

third party incentive programs that have been identified by the host for listing on a directory (the

host distributes incentive programs on behalf of a sponsor- col. 12: 38-48). The consumer may

also link to the promoter's or sponsor's site (figs. 8, 13, 18).

In general, the system is operable to determine, upon a user's visit, whether or not the

user is registered with the system by searching for the user's data in consumer database 200. If

the consumer (data) is not found in the consumer database 200 at the step 309, then the consumer

is immediately prompted to respond whether the consumer wishes to register as a member of the

host system at a step 306. If the consumer wishes to register at the step 306, then the consumer is

prepared to complete a registration process at the step 306. If at the step 306 the consumer

declines to register, then the consumer is returned at a step 320 to a message informing the

consumer that the host system's capabilities require registration in order to participate in the

incentive distribution system. **Once the consumer is registered via the registration process,**

the consumer database 200 is updated at a step 321 and the consumer returned to a page,

related to the host system or host site, at step 304 reflecting or having the directory of

options (incentive options) available to the consumer where the consumer can select one or

more incentives from a menu (automatically returning the user to the host site subsequent to a registration process taken place at a web page).

In summary, if the user indicates the desire to register, then the HTTP server displays an HTML page (in the local browser window) that may include a table format for input of data by the consumer necessary for registration. Upon registering via the inputted data on the HTML page, the associated HTTP server calls a CGI script, which calls an application program to update the consumer database 200 in real-time by adding the consumer (registration data) to the consumer database 200 and by adding records in the database that reflect the data entered through the HTML page by the consumer at the registration step. Once the consumer has entered a name and password, **or a new consumer has registered, the consumer is sent, step 304 of fig. 8, back to the original HTML page (of the host site or web site) where he may select one or more available incentives subsequent to the registration process. Here, step 304, depicting a process for viewing a directory or menu of incentive options, is accomplished by the HTTP server of the host computer displaying an HTML page that displays various icons that permit the user to select available options** (Col.16: 14-35; figs 8-10).

Any incentive program may be provided, as long as some algorithm (rule) for determining a winner is available. Thus, a sweepstakes-style incentive program accumulate entries over a defined period of time and award prizes to recipients or **registered** users according to a probability (rule0 algorithm that relies on a **random number generator (that randomly selects one or more recipients as winners). Alternatively, incentive programs may be customer loyalty programs in which consumers accumulate points for performing certain actions, and the accumulation of a defined or target number of points permits eligibility for**

a prize related to, for example, a game of skill such as a trivia game in which a selected

recipient, who has accumulated a target number or predefined number of loyalty points,

has to answer one or more questions (quiz aspect) to thereby determine whether or not the

selected recipient is a winner of the trivia game. Moreover, incentive programs may be

combinations of types; thus, successful completion of a customer loyalty program might render a

consumer eligible for a sweepstakes prize, or victory in a sweepstakes might provide customer

loyalty points for a prize. Incentive programs may also be parallel, in that victory in a

sweepstakes might provide an immediate prize, as well as points in a customer loyalty incentive

program (col. 35: 21-37).

Sponsors are able to target awards for giveaway by demographic preferences or

geography. Sponsors able to incent with multiple products of various price points

efficiently. The system creates increased traffic to retail outlets, even though the

promotion may begin in cyberspace. An electronic card is provided to the customer to

facilitate redemption at a retailer's location of a prize won by a customer or winning

recipient and the card is also used by the retailer as a tracking mechanism to monitor the

customer's purchasing behavior or pattern. The card is potentially more functional than

an in-store card because it may be acceptable across several chains or merchants or

restaurants, etc., but it is similar in that it tags a purchase in order to store information

about consumer purchasing behavior (col. 42: 33-49).

In general, a typical consumer may log on to the system web site, register as with the host

system, and participate in one or more incentive programs. The incentive programs could

include, for example, scratch-and-win games, sweepstakes games, treasure hunt games, trivia

games or computer games. Participation in the incentive programs could include entering data, completing surveys, clicking on one or more icons in a predetermined manner, or other "win eligible" activities, such as answering questions. When the consumer wins an incentive program, the incentive program software algorithm indicates that a "win" has been accomplished **and informs the consumer of the appropriate prize· The databases are then updated to reflect that the consumer has won the prize.** The prize could include retail merchandise, but loyalty points, discounts, coupons, and the like. Thus, for example, a consumer participating in a scratch-and-win game for a rental car company might receive, upon winning the scratch-and-win game (game of chance), a number of loyalty points in the rental car loyalty program. Incentive program award techniques for all types of incentive programs can be embodied in the present system. **Thus, loyalty points can be awarded for participation with respect to multiple retailers,** and merchandise can be awarded by the sponsor offering the incentive program or by third party retailers. It is further to be understood here that accumulated loyalty points earned by the customer for performing certain actions can also be used as an eligibility criterion to participate in an incentive program (such as a game of skill) such that, upon collecting a preset number of loyalty points, the customer can participate in the trivia game and answer one or more questions to win a prize such as a merchandize or more loyalty points offered by the program sponsor (col. 13: 43-67).

Finally, it should be understood that all loyalty points received from a plurality of participating merchants or retailers for performing certain actions thereto and accumulated by a recipient are available for use or a portion of these accumulated are used as an eligibility criterion to permit the recipient to participate, for example, in a game of skill to answer one or

more questions for the chance to win a prize redeemable at a merchant or retailer directly or

indirectly associated with the game. Loyalty points that are used or redeemed are being

subtracted from the recipient stored accumulated points, while newly earned points, for

performing certain actions or winning the outcome of a game, are being added to the existing

(previously) stored and accumulated loyalty points. It should also be noted that sponsors or

merchants individually offer these incentive programs (a series of incentive programs), via the

host system web site over the Internet, to thereby attract potential customers. The sponsors can

buy pre-packaged incentive programs from the host system or the sponsors can build or develop

their own incentive programs. In either case, the sponsors are prompted to enter incentive

parameters such as the starting date and the duration for each incentive program (game of skill)

made available via the host system web site. It is further to be recognized that when an

incentive program expires (end of the duration period) or when the promotional campaign

associated with the series or plurality of incentive programs ends, any loyalty points that were

not or redeemed are considered null and void (or useless) since the promotional campaign

related to distribution of the loyal points reaches its end (... where a few programs are run as a

series according to pre-determined rules, all loyalty numbers issued are retained until the end of

the series. Only at the end of the series, these loyalty numbers are rendered null and void. After

the first selection process, all those previously issued loyalty numbers are carried forward to the

next program. Only after the last selection process, all loyalty numbers are rendered null and

void. Relevant member consumer records, member merchant outlet records and transaction

records are then "emptied" accordingly- Spec. page 9:14-22). See fig. 10 and col. 18: 64 to col.

19: 31).

As per claims 1 and 6, although Eggleston discloses, in an **alternate embodiment, incentive programs that may be customer loyalty programs in which consumers accumulate points for performing certain actions, and the accumulation of a defined or target number of points permits eligibility for a prize related to, for example, a game of skill such as a trivia game in which a selected recipient, who has accumulated a target number or predefined number of loyalty points, has to answer one or more questions (quiz aspect) to thereby determine whether or not the selected recipient is a winner of the trivia game, however,** Eggleston does not expressly teach a method of and a system for issuing and storing in a database loyalty points to a recipient for each individual qualified transaction taken place at a participating merchant contingent upon the merchant's stored agreed amount associated with each qualified transaction (points issuing ratio).

However, Ikeda discloses a point-service system (incentive reward program) for issuing points to a customer for purchases made at various stores or shops within an online shopping mall comprising a points issuing unit 1 of fig. 1 for issuing points based on purchase amounts of he customer or participant (col. 3: 52-53), a points management unit 2 of fig. 2 for storing the points accumulated by the customer and a points redeeming unit 3 of fig. 1 for reducing a purchase amount of the customer upon redeeming points at any participating store within the mall. This system shortens the time from issuing points to redeeming points. In one embodiment, Ikeda discloses a service system wherein a specific customer makes a request to buy goods (participant's action) from a home page of an online shopping mall and in response to this

request, the service system causes the number of effective points (base points) accumulated by the customer and issued by a plurality of shops for each purchase made at each respective shop to be displayed on the customer's terminal or participant's unit, subsequent to identifying the customer or participant using the customer's or participant's ID, by referring to the data of each shop forming part of the online shopping mall. If the customer still decides to order a product (participant's action), he can click on a shopping button associated with one of the displayed shops to subsequently access an order button and. hence, the point-service system or service system linked to a web server of the online shopping mall is activated to issue points or redeem points at the customer's request or instructions when he inputs an order (see abstract; col. 2: 10-67; figs. 1-19). It is to be understood that a customer can explicitly or implicitly make a request from the point-service system to buy a product from a participating shop, redeem points or simply query the point-service system database for the effective points (base points) accumulated to date (col. 5: 22-38; col. 4: 34-40; col. 10: 55 to col. 11: 3).

Moreover, the points issuing unit issues points based on the purchase amount of a customer or participant at an online shopping mall. The point issuing unit issues points based upon, for example, input information such as the name of the shop and the purchase amount and the points issue ratio set for each shop. For example, the points issue ratio is indicative of how many points are issued when a customer or participant spends 100 Yen at a shop (1 point for every 100 Yen spent). The points issue ratio can also be set to a value larger than a normal value in a special campaign period such as an end-of-year sales period (col. 2: 28-37).

In addition, a points redeeming ratio performs a points redeeming process by reducing the purchase amount for a particular customer or participant during a transaction at a specific shop,

based on the number of total points (base points or effective points) accumulated thus far

throughout the system or at that shop, wherein the customer or participant chooses to redeem

some of his points (base points) at the specific shop and wherein each participating shop has a

different points redeeming ratio (providing a second reward program that assigns a redemption

rate for a customer's transaction based on the redemption points ratio available at the shop,

wherein the customer's program points are functions of the effective or base points issued and

the redemption points ratio set for the shop). For example, shop A of fig. 9 reduces during a

certain period of time the customer's purchase by 1 Yen for every 1 point redeemed, hence a 1:1

ratio or redemption rate. Like the points issue ratio, the points redeeming ratio or redemption rate

for a specific period, such as an end-of-year sales campaign, can be set to a value higher than a

normal period (increasing or adjusting or providing a higher redemption points ratio or

redemption rate to the customer if the customer performs an action such as purchasing products

at a shop participating in the end-of-year sales campaign). For instance, 10, 000- 2 indicates that

the points issue ratio will double when the number of accumulated points reaches 10,000 points

(2 points for every 100 Yen spent upon reaching 10, 000 effective or base points). Further, the

point redemption ratio or rate for shop F, during a specific period of time, doubles that of the

other shops, thus a 2:1 ratio (2 Yen for every 1 point redeemed) (col. 2: 38-64: col. 3: 62-67; col.

8: 1-23; col. 9: 55 to col. 10: 2). In other words, each specific shop issues points to a customer or

redeems the customer's effective points (base points) during a purchase transaction in

accordance with the points issue ratio and points redemption ratio set for each specific shop

during a specific period of time. **In short, a customer can be allowed special services if he**

buys goods at the same shop (performing an action), for example shop A, by setting the

points redeemed ratio or point redemption rate for the customer or participant higher than the common points redeeming ratio of the online shopping mall (adjusting the customer's or participant's redemption rate when he performs an action such as patronizing the same shop). Here, it is to be understood that two customers redeeming the same number of effective points or total accumulated points or base points (**action points**) during a purchase transaction (performing the same action) at the same shop or shop A will be assigned two different redemption rates. One customer will receive a standard redemption rate and the other a higher redemption rate for being a loyal customer (col. 11: 50-53).

(Col. 6: 29-38; col. 10: 16-30; col. 10: 55: to col. 11: 62; col. 11: 63 to col. 12: 20; col. 13: 28-32; figs. 6, 9 and 14-15).

Thus, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the points issuing and redeeming system of Ikeda into the Eggleston's system so as to issue loyalty points to a registered customer for each transaction at a participating shop or registered merchant, that provides points, in accordance with the amount of money spent or the transaction value and the points issuing ratio at the shop, wherein when the total points accumulated by the customer for purchases made at a plurality of registered shops within the shopping mall system reach a predetermined target number or predetermined threshold (eligibility criterion), then the customer is allowed to participate in an incentive program or enter a game of skill (a trivia game), offered by a sponsor or merchant or shop, and answer one or more questions for the opportunity to win a prize, such as a merchandize, redeemable at a shop or merchant's store, thereby encouraging the customer to actively patronize or support the shops

or merchants' stores and earn loyalty points that permit the customer to participate in an

incentive program (game of skill) offered by a sponsor for the chance to win a prize redeemable

at a registered shop or merchant's local store, while enabling the merchant to establish an

ongoing relationship with the customer who is incentivized to buy from the registered

merchant's rather than a competitor's and consequently the merchant is able to increase his

business bottom line.

Conclusion

Any inquiry concerning this communication from the Examiner should be directed to

Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally

be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner

by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached

at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-

1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final-   703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ
03/01/05

JEAN D. JANVIER
PRIMARY EXAMINER